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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/304,035	05/03/1999	GIORGIO J. VANZINI	MSI-254US	9156
22801	7590	01/15/2004	EXAMINER	
LEE & HAYES PLLC			KIM, AHSHIK	
421 W RIVERSIDE AVENUE SUITE 500			ART UNIT	
SPOKANE, WA 99201			PAPER NUMBER	

2876

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/304,035	VANZINI ET AL.	
	Examiner	Art Unit	
	Ahshik Kim	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE & Prelim Amdt (10/17/03).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,22-26 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,22-26,39-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
37 CFR 1.114. Applicant's submission filed on October 17, 2003 has been entered.
2. In the amendment filed on October 17, 2003, Applicant wrote " In response to the Final
10 Office Action of March 5, 2003", which Applicant later called and corrected it to be the Final
Office Action of August 19, 2003.

Preliminary Amendment

3. Receipt is acknowledged of the preliminary amendment filed on October 17, 2003. In the
15 amendment, claims 2 and 3 were canceled; claims 1, 5, and 6 were amended; and claims 39-53
were newly added. Currently, claims 1, 4-6, 22-26, and 39-53 remain for examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
20 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2876

5. Claims 1, 4-6 and 22-26, 45-48 50-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Harari et al. (US 5,887,145).

Re claims 1, 22, and 50, Harari teaches a PCMCIA form factor device 10 (col. 3, lines 19-23; col. 6, lines 63+) comprising an interface 14 to communicate with a storage card 20. The card assembly 100 can be connected to a host machine/system (see abstract; col. 1, lines 13+).

Re claim 23, 48 the storage card contains various chips such as flash EEPROM memory (col. 7, lines 24-+).

Re claims 4, 5, 24, and 51, the storage card 20 further contains identifying data readable from the mother card or the host, which in turn can be used in guiding the host to use a particular device protocols or software (col. 5, lines 38+).

Re claims 6, 25, 26, 45-47, 52, and 53 the daughter card 30 stores an assignable identity code and a secret key (private key in RSA public-key data encoding scheme) (col. 13, lines 64+). Only when the private-public keys are matched, the information can be decrypted and read.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2876

7. Claim 49 is rejected under 35 U.S.C. 102(e) as being anticipated by Ban et al (US 6,148,354, "Ban" hereinafter).

Ban teaches a removable USB-compatible flash memory to store user data (see abstract; col. 4, lines 59+).

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

10 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15 9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later
20 invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harari et al. (US 5,887,145) in view of Ban et al (US 6,148,354). The teachings of Harari have been discussed above.

25 Although Harari discloses an interface 54 to the host machine (col. 7, lines 54+), Harari to specifically teach or fairly suggest that one of the interfaces is USB interface.

Art Unit: 2876

Ban teaches a flash memory card comprising USB interface (i.e., USB connector, USB logical/physical interface and USB functional interface) (see figure 6; col. 1, lines 43+; col. 4, lines 59+).

5 In view of Ban's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to alternately employ well-known USB interface to the teachings of Harari in order to communicate with host machine which uses USB standard. USB interface is often smaller in size and easier for the end users. Moreover, it is the Examiner's view that communication protocol such as PCMCIA interface, USB interface, SCSI and RS232 interface are functionally equivalent in that host and the card can communicate using any of the
10 communication protocols. Accordingly, one ordinary skill in the art would choose an interface best fitting the needs of the one's embodiment.

Response to Remarks

11. Applicant's amended claims, newly added claims and remarks were carefully considered.
15 Applicant argues that the mother card (in Harari reference) does not contain any substantial amount of flash EEMPROM storage (see Remarks page 8, 5th paragraph thereafter).

Examiner respectfully disagrees with Applicant's assertion. As shown in figures 6 and 7 (col. 9, lines 10+) the main memory of the mother card can be a flash memory. It is the Examiner's view that the references to Harrari and Ban still teach the claimed subject matter
20 disclosed in the outstanding amendment filed on October 17, 2003.

Art Unit: 2876

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Jones et al. (US 6,438,638); Harari et al. (US 5,671,229); Tso (US 5,890,016); Aoki (US 5,438,359) disclose flash memory card/assembly. Although not relied on in the Office Action, Applicants are respectfully suggested to review these prior arts.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

15 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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Ahshik Kim
Patent Examiner
Art Unit 2876
January 6, 2004

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